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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,064	04/13/2001	Giovanni Giuffrida	HRL065	3890
28848	7590	11/01/2005		
TOPE-MCKAY & ASSOCIATES 23852 PACIFIC COAST HIGHWAY #311 MALIBU, CA 90265				
EXAMINER ABEL JALIL, NEVEEN				
ART UNIT		PAPER NUMBER		
2165				

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/835,064

Applicant(s)

GIUFFRIDA ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/11/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

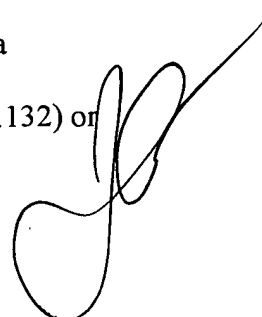
### Remarks

1. In view of the Appeal Brief filed on 7-October-2005, PROSECUTION IS HEREBY REOPENED. *A new ground of rejection is set forth below.*

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).



### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-16 are rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 1 recites “An apparatus for” without further stating any tangible device that is non-statutory for at least the reason that it is not tangibly embodied in a manner so as to be executable.

To overcome this type of 35 U.S.C. 101 rejection, claim 1 need to be amended to include “An apparatus comprising a data processor”.

Claims 2-8 are dependent on Independent claim 1 and therefore carry the same deficiency.

Claim 9 recites “A method for” without further stating any concrete or tangible embodiment and therefore non-statutory for at least the reason it is an abstract idea.

To overcome this type of 35 U.S.C. 101 rejection, claim 9 need to be amended to include “the method being executable by a computer”.

Claims 10-16 are dependent on Independent Claim 9 and therefore carry the same deficiency.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, the recitation of “is further configured” renders the claim to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner what the first processing element was initially configured to perform or how else is the first processing element can be configured.

In claim 1, line 12, the recitation of “to also provide” renders the claim to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner how else is the database configured to do or what other steps is the database providing?

Claim 1, line 9, recites the limitation “extract predetermined information” then the claim further recites “extracting metadata” it is unclear to the Examiner what the difference between the two claimed limitations if any exist and if there’s a clear and precise difference then it should be disclosed in the claim thereby renders the claim to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner does not find a clear definition of the “extracted predetermined information” in the specification.

Furthermore, it is unclear to the Examiner how the two sets of extracted information/metadata are linked together in order to perform the steps of the claimed invention. If there’s a clear and precise difference then it should be disclosed in the claim. In the Specification a definition of “extracting predetermined information” is merely stated as

Art Unit: 2165

“extracting the desired information” (See specification paragraph 0063) and only stated as such in paragraph 0069 under “another embodiment” of the invention and not stated in the overall all invention or the preferred embodiment.

Independent Claim 9 carry the same deficiency.

Claims 2-8, and 10-16, are dependent on Independent claims 1, and 9, respectively and therefore carry the same deficiency.

6. Regarding claims 2 and 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahoney et al. (U.S. Patent No. 5,999,664).

As to claim 1, Mahoney et al. discloses an apparatus for automatically extracting metadata from electronic documents comprising a first processing element, a second processing element, a reasoning element, and a database, wherein,

- i) said first processing element is further configured to convert electronic documents into files (See column 7, lines 43-53);
- ii) said first processing element is configured to provide the files to a second processing element (See column 5, lines 23-36);
- iii) said second processing element is configured to receive said files and extract predetermined information (See column 4, lines 46-58, also see column 8, lines 10-24);
- iv) said second processing element is further configured to provide said extracted predetermined information to said reasoning element (See column 8, lines 41-51);
- v) said database is configured to also provide input to said reasoning element (See column 8, lines 53-65);
- vi) said reasoning element is configured to use a set of rules to extract metadata from the files (See column 4, lines 46-58, also see column 9, lines 19-31, also see column 10, Table 1, shows “Rules”);
- vii) reasoning element provides an output of metadata (See column 9, lines 32-51).

As to claims 2, and 10, Mahoney et al. discloses an apparatus for automatically extracting metadata from electronic documents, wherein said files are substantially format invariant data files such as Postscript files (See column 14, lines 11-44, column 1, lines 34-37, prior art).

As to claims 3, and 11, Mahoney et al. discloses wherein said predetermined information is substantially spatial layout facts (See column 5, lines 46-61).

As to claims 6, and 14, Mahoney et al. discloses wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents (See column 4, lines 47-56, and see column 9, lines 23-31).

As to claims 4, and 12, Mahoney et al. discloses wherein the second processing element and said database simultaneously input to the reasoning element (See column 2, lines 4-16).

As to claims 5, and 13, Mahoney et al. discloses wherein said set of rules can be updated (See column 2, lines 17-36, wherein set of rules” reads on genre or “predefined form”, also see Figure 9, 990, Arrange Summarized Documents According To Display Profile).

As to claims 7, and 15, Mahoney et al. discloses wherein said metadata is provided to a user interface (See Figure 7).

As to claims 8, and 16, Mahoney et al. discloses wherein said metadata is provided to a storage medium (See Figure 2).



As to claim 9, Mahoney et al. discloses a method for automatically extracting metadata from electronic documents comprising a first processing element, a second processing element, a reasoning element, and a database, and comprising the steps of:

- i) using said first processing element to convert electronic documents into files (See column 7, lines 43-53);
- ii) further using said first processing element to provide the files to a second processing element (See column 5, lines 23-36);
- iii) using said second processing element to receive said files and extract predetermined information (See column 4, lines 46-58, also see column 8, lines 10-24);
- iv) further using second processing element to provide said extracted predetermined information to said reasoning element (See column 8, lines 41-51);
- v) using said database to provide input to said reasoning element (See column 8, lines 53-65);
- vi) using a set of rules in said reasoning element to extract metadata from the files (See column 4, lines 46-58, also see column 9, lines 19-31);
- vii) providing an output of metadata from said reasoning element (See column 9, lines 32-51).

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil  
October 27, 2005

JEFFREY GAFFIN  
SUPERVISOR  
